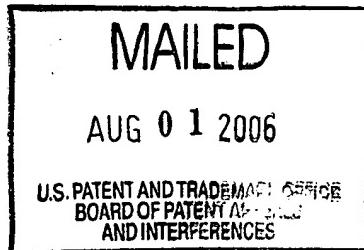


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TRENT J. BRUNDAGE

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Application 09/854,408

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on July 28, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that appellant filed an Appeal Brief on January 3, 2006. In response, an Examiner's Answer was mailed March 21, 2006.

Section § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(1) Real Party in Interest. A statement acknowledging that the brief has identified b name the real party in interest.

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

It is noted that while the Examiner's Answer states that “[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal” [page 4 under the caption “Evidence Relied Upon”], the claim rejections are listed as follows:

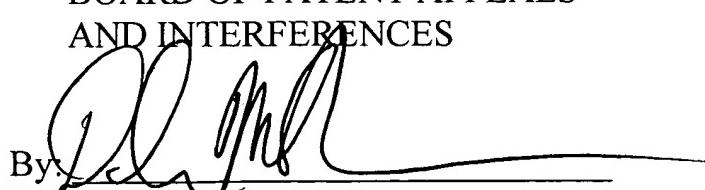
1. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent 5,113,445 [page 4]; and
2. Claims 1-11, 12-16, 17-20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent 5,113,445, further in view of Rhoads, U.S. Patent 5,862,260, and further in view of Schaffer et al., U.S. Patent 6,282,528 B1 [page 7].

Correction is required.

In addition, the Examiner's Answer includes a new ground of rejection "in response to the Applicant's after final addition of 'orientation date' and 'said controlling positioning or movement of an item including the digital watermark'" [page 3]. However, this Answer is deficient pursuant to § 1207.03 of the MPEP which states that "[a]ny new ground of rejection made by an examiner in an answer must be: (A) approved by a Technology Center (TC) Director or designee." Correction is required.

Accordingly, it is

- ORDERED that the application is returned to the Examiner:
- 1) for submission of a revised Examiner's Answer which adds the "Real Party in Interest" section and corrects the "Evidence Relied Upon" section; and
  - 2) for obtaining a Technology Center (TC) Director or designee's signature on the Examiner's Answer mailed March 21, 2006; and
  - 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES  
  
By: \_\_\_\_\_  
DALE M. SHAW  
Deputy Chief Appeal Administrator  
(571) 272-9797

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